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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/564,993

03/01/2006

Peter Reich

2006-0033A

7192

513 7590 01/14/2009

WENDEROTH, LIND & PONACK, L.L.P.

2033 K STREET N. W.

SUITE 800

WASHINGTON, DC 20006-1021

EXAMINER

DICUS, TAMRA

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

01/14/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/564,993	<b>Applicant(s)</b> REICH, PETER	
	<b>Examiner</b> TAMRA L. DICUS	<b>Art Unit</b> 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) 15 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>01/18/06</u> .  | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Election/Restrictions***

Acknowledgement is made of the election of Group I, claims 1-14 with traverse. Group II, claim 15 is withdrawn and therefore not addressed in this prosecution.

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is replete with lack of antecedent basis for the following: “the appropriate imprint”, “in those regions”, “similar composition”, “the printing ink”, “the curing agent”, and “the fill good”.

Also it is not clear what the “fill good” means.

It is not clear what layer the curing agent is in.

Further it is not clear what the order is because of the use of “and/or”.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3, 6-8, 10 and 12-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Hiatt (US 5,284,688).

Hiatt teaches a label as shown in FIG. 1 and 2 having ink 10, UV curable adhesive 12 and heat sealing lacquer layers 8. See the workpiece 20, in Fig. 2. Either order of Figs. 1-2 meets claim 1. The lacquer comprising curing agent (acrylate-8:18-20 ethylene acrylate average molecular weight is inherent) and adhesion promoter (photoinitiator-8:45-46). The lacquer may be colored. See cols. 6-10.

To claims 1-3, 6, 10, and 12-14 when and how the different elements are applied are process limitations in a product claim. Product-by-process claims are not limited to the manipulations of the recited steps, only the structure implied by the steps. Patentability of an article depends on the article itself and not the method used to produce it (see MPEP 2113). Furthermore, the invention defined by a product-by-process invention is a product NOT a process. *In re Bridgeford*, 357 F. 2d 679. It is the patentability of the product claimed and NOT of the recited process steps which must be established. *In re*

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*Brown*, 459 F. 2d 531. Both Applicant's and prior art reference's product are the same.

Hiatt teaches a label adhered to an object or workpiece. This is seen as functioning as an imprinted sheet material for container coverings since the same material and structure is taught, see MPEP 2111.02. Without such reliance, however, a preamble is generally not limiting when the claim body describes a structurally complete invention such that deletion of the preamble phrase does not affect the structure or steps of the claimed invention.

Consequently, "preamble language merely extolling benefits or features of the claimed invention does not limit the claim scope without clear reliance on those benefits or features as patentably significant." In *Poly-America LP v. GSE Lining Tech. Inc.*, 383 F.3d 1303, 1310, 72 USPQ2d 1685, 1689 (Fed. Cir. 2004).

Claims 1-3, 6-8, 10 and 12-14 are met.

The reference is anticipatory.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Claims 4-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,284,688 to Hiatt, as applied to claim 1, in view of US 6,617,000 B1 to Denny et al.

Hiatt does not teach registration lines (claims 4-5).

Denny teaches an adhesive label with registration lines for indicating folds. See Abstract, 5:15-30.

It would have been obvious to one having ordinary skill in the art to have modified the label of Hiatt incorporating lines for the purpose of indicating folds as taught by Denny cited above.

Claims 8-9, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hiatt (US 5,284,688) is relied upon above.

Hiatt teaches a label as set forth above.

Hiatt doesn't teach ratio mix (claim 8-9). It is submitted the optimal and/or claimed values of the respective material would have been obvious to the skilled artisan at the time the invention is made since it has long being held that such discovery, such as an optimum value of the respective result effective variable involves only routine skill in the art. *In re Boesch*, 617 F.2d 272,205 USPQ 215(CCPA 1980). See also MPEP § 2144.05 II (B).

Hiatt doesn't teach a pigmented promoter (claim 13).

However, it is known to pigment adhesives for coloring and aesthetic design purposes, therefore there would be a reasonable expectation of success

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to modify the prior art to arrive at the instantly claimed invention to result in aesthetic design. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate pigment for decorative purposes. Though we are fully cognizant of the hindsight bias that often plagues determinations of obviousness, Graham v. John Deere Co., 383 U.S. 1, 36 (1966), we are also mindful that "the combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results," KSR Int'l Co. v. Teleflex Inc., 127 S. Ct. 1727, 1739 (2007). In view of the forgoing, the above claims have failed to be patently distinguishable over prior art.

Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hiatt (US 5,284,688) as applied to claim 1, in view of Dronzek, Jr. (US 6517664 B1).

Hiatt teaches the claimed invention relied upon above.

Hiatt does not teach claim 11.

Dronzek, Jr. teaches a label including polyfunctional aziridine with acryls for the curing agent (catalyst)-see 6:30-45, Example 3.

It would have been obvious to one having ordinary skill in the art to have modified the primary reference to include the claimed agent to aid in crosslinking the resin used in labels as taught by Dronzek, Jr.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to TAMRA L. DICUS whose telephone number is (571)272-1519. The examiner can normally be reached on Monday-Friday, 7:00-4:30 p.m., alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Larry Tarazano can be reached on 571-272-1515. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/D. Lawrence Tarazano/  
Supervisory Patent Examiner, Art Unit 1794

Tamra L. Dicus /TLD/  
Examiner  
Art Unit 1794



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December 27, 2008